

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re Application of | : | Customer Number: 46321 |
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| Miguel a. ESTRADA, et al. | : | Confirmation Number: 4386 |
| | : | |
| Application No.: 10/731,823 | : | Group Art Unit: 3629 |
| | : | |
| Filed: December 9, 2003 | : | Examiner: Jonathan P. Ouellette |
| | : | |
| For: METHOD AND SYSTEM FOR COLLABORATIVE COMMUNITY MEMBERSHIP MANAGEMENT | | |

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated December 24, 2008.

The Examiner's response to Appellants' arguments submitted in the Appeal Brief of October 6, 2008 (hereinafter the Appeal Brief), raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Appeal Brief, and the arguments set forth below.

REMARKS

Appellants have compared the statement of the rejection found on pages 3-4 of the Examiner's Answer with the statement of the rejection found on pages 2-5 of the Final Office Action. Upon making this comparison, Appellants have been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellants proceed on the basis that the Examiner's sole response to Appellants' Appeal Brief is found on pages 3-4 of the Examiner's Answer.

Non-Compliant Examiner's Answer

On page 4 of the Appeal Brief, Appellants pointed out where the Examiner's Answer is required to include particular content discussed in M.P.E.P. § 1207.02, yet the Examiner has completely ignored this requirement. As noted throughout the prosecution of this application and in the Appeal Brief, the Examiner has failed to properly establish the facts underlying the Examiner's analysis. Appellants' position is that these omissions in the Examiner's prima facie analysis are correctable by the Examiner, and the correction of these omissions would help both Appellants and the Honorable Board gain a better understanding of the findings of facts and analysis employed by the Examiner in rejecting the claims. Thus, Appellants respectfully recommend that the Honorable Board remand the present application to the Examiner to address these omissions.¹ As Appellants have specifically identified in Appellants' Amendment dated

¹ The Board has persistently declined to uphold an Examiner because of omissions in the Examiner's half of the record. E.g., Ex parte Dalciden, Appeal 2007-1003 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); Ex parte Rozzi, 63 USPQ2d 1196, 1200-03 (BPAI 2002) (remanding without decision because of a host of examiner omissions and procedural errors); Ex parte Gambogi, 62 USPQ2d 1209, 1212 (BPAI 2001) ("We decline to tell an examiner precisely how to set out a rejection."); Ex parte Jones, 62 USPQ2d 1206, 1208 (BPAI 2001) (refusing to adjudicate an issue that the examiner has not developed); Ex parte Schriker,

November 1, 2008 and in page 7, last page to page 8, first paragraph of Appellants' Appeal Brief:

[I]n this case the Examiner has failed to cite to anything at all in Hatscher in rejecting dependent claims 2-7, 9-14 and 16-20. Appellants previously raised this very deficiency to the attention of the Examiner on page 12 of Appellants' Amendment dated November 1, 2008, wherein Appellants stated:

The Applicants note that **the Examiner has chosen not to specifically apply any portions of Hatscher in rejecting Claims 2-7, 9-14 and 16-20.** The Applicants take issue with the Examiner's course of conduct in this regard and remind the Examiner of the Examiner's responsibility in providing a proper examination under 37 C.F.R. 104(c)(2)...

Once again the Examiner has decided to ignore these requirements and to fail to provide the Appellants with a "full and fair hearing".

Rejection of claims 1, 8 and 15 under 35 U.S.C. § 102

In response to Appellants' arguments found on page 11, paragraph 4 through page 14 paragraph 1 of the Appeal Brief, the Examiner asserted the following on page 4, paragraph 2 through paragraph 3, of the Examiner's Answer:

1. The Appellant has made the argument that the cited prior art fails to teach or suggest receiving an indication from one or more invitees that the invitee wishes to join the community.

2. However, Hatscher does disclose notifying people about the community (Para 0053, Invitation) and requesting the potential members to subscribe if they want to receive community information (Fig.7G); therefore, the subscription of new members would be an indication of user's wish to join a community (emphasis added)

As already argued in the Appeal Brief, the Examiner has not established **"receiving an indication from one or more invitees that the invitee wishes to join the community."** The

56 USPQ2d 1723, 1725 (BPAI 2000) ("The examiner has left applicant and the board to guess as to the basis of the rejection ... We are not good at guessing; hence, we decline to guess."); *Ex parte Bracken*, 54 USPQ2d 1110, 1112-13 (BPAI 1999) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

Examiner appears to be making an inherency argument that by joining a community, the invitee has inherently made a notification that the invitee wishes to join the community. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.² To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.³ However, the Examiner did not discharge the burden of indicating where such a teaching appears in the prior art. Thus, the Examiner has not established that this limitation is inherently disclosed by Hatscher. Moreover, it is not necessary that an invitee make an indication "that the invitee wishes to join the community" when an invitee actually joins the community. In other words, the invitee does not have to send a notification or indication, e.g., reply email, select a HTML link in the invitation e-mail, etc., that the invitee wishes to join the community.

As disclosed in Appellants' patent specification: "Membership processing (step S106) is explained in detail with reference to FIG. 5. Once invited, end user person 14 indicates that they want to join the group ... for example by selecting the HTML link from the invitation e-mail received." Appellants' specification at paragraph [0034] (emphasis added). This paragraph supports Appellants' arguments that an invitee takes an active step to provide "that the invitee wishes to join the community".

² In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

³ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

Therefore, Appellants maintain that the Examiner has erred in rejecting claims 1, 8 and 15 under 35 U.S.C. § 102 for anticipation based upon Hatscher.

Claims 2-7, 9-14 and 16-20

Once again, the Appellants note that the Examiner has chosen not to specifically apply any portions of Hatscher in rejecting Claims 2-7, 9-14 and 16-20. As previously argued in the Appeal Brief, these omissions in the Examiner's prima facie analysis are correctable by the Examiner, and the correction of these omissions would help both Appellants and the Honorable Board gain a better understanding of the findings of facts and analysis employed by the Examiner in rejecting the claims. Thus, Appellants respectfully recommend that the Honorable Board remand the present application to the Examiner to address these omissions.

For the reasons set forth in the Appeal Brief, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-3829, and please credit any excess fees to such deposit account.

Date: March 9, 2009

Respectfully submitted,

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